

# Notice of Allowability

Application No.

09/937,631

Examiner

Andrea D Small

Applicant(s)

MULLER ET AL.

Art Unit

1626

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 10/14/2003.
2. ☒ The allowed claim(s) is/are 2-4 and 6-11, renumbered 1-9.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
  - \* Certified copies not received: \_\_\_\_\_.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No. \_\_\_\_\_.
  - (b) ☐ including changes required by the proposed drawing correction filed \_\_\_\_\_, which has been approved by the Examiner.
  - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. \_\_\_\_\_.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

- |  |   |
|--|---|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                  |
| 2 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | 6 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>11/14</u> . |
| 3 <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No. <u>9/01</u> | 7 <input checked="" type="checkbox"/> Examiner's Amendment/Comment                          |
| 4 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material                 | 8 <input type="checkbox"/> Examiner's Statement of Reasons for Allowance                    |
|  | 9 <input type="checkbox"/> Other _____  |

## DETAILED ACTION

### *I. Preliminary Matters:*

(a) Applicants response of 10/14/2003 has been received and entered into the file.

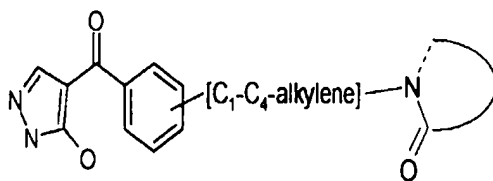
-Claim 1 has been cancelled.

-Claims 12-19 have been newly added.

-Claims 2-4 and 6-19 are pending.

### *II. Remarks:*

(a) Restriction/Election: Applicants traversed the restriction requirement based on the technical

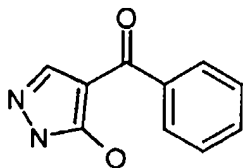


features being

and thus this feature

would provide a contribution over the art and hence the claims would have unity of invention.

The examiner respectfully disagrees. The technical features are those that can be taken as a whole that are in common among all the groups. Instantly, those technical features are



, which was known in the art prior to the filing of the instant

application. Therefore, the inventions as grouped lack unity of invention and the restriction as outlined is proper and maintained.

In a telephone conversation with Mr. Harmuth, the traversal as to the restriction was withdrawn.

(b) Objections:

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- (i) Applicants have amended claims 2 and 3 to overcome the objections cited against said claims.
- (ii) Applicants have amended claims 2-3 and 6-10 to limit said claims to the elected subject matter, therefore, the objection to these claims has been withdrawn.

***III. Examiner's Amendment:***

An examiner's amendment to the claims is attached to the instant office action which cancels claims 12-19. Applicants representative Mr. Raymond Harmuth provided permission to amend the claims.

***IV. Reasons for Allowance:***

Claims 2-4 and 6-11 relate to compounds according to formula I in claim 2. The closest art of record, WO 99/07697 does not teach or fairly suggest the substituents at the R1 position or the substituents on the Z moiety as instantly claimed. Therefore, claims 2-4 and 6-11, renumbered 1-9 are allowed.

***V. Contact Information:***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small, whose telephone number is (703) 305-0811. The examiner can normally be reached on Monday-Thursday from 8:30 AM - 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (703) 308-4537. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (703) 308-4556 or 305-3592.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

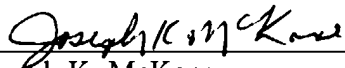
Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [Joseph.McKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive

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data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (703) 308-1234

Andrea D. Small, Esq.  
November 14, 2003

  
\_\_\_\_\_  
Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626  
Technology Center 1

### EXAMINER'S AMENDMENT TO THE CLAIMS

Cancel claims 12-19.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea D. Small, whose telephone number is (703) 305-0811. The examiner can normally be reached on Monday-Thursday from 8:30 AM - 7:00 PM.

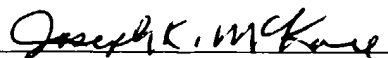
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Andrea D. Small, Esq.  
November 14, 2003

  
\_\_\_\_\_  
Joseph K. McKane  
Supervisory Patent Examiner  
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